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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/761,670

01/18/2001

Jeffrey Scott Eder

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02/13/2009

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3695

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY SCOTT EDER

Application 09/761,670
Technology Center 3600

Mailed: February 13, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on July 10, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, HEADINGS

A review of the file indicates that the Appeal Brief filed October 22, 2007 does not comply with 37 CFR § 41.37(c)(1)(x) which states:

(x) *Related proceeding appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

The “Related proceedings appendix” is deficient because it only contains the first page of the August 29, 2007 decision rendered in Application No. 09/761,671 (Appeal No. 2007-2745). A copy of the entire decision is required.

EXAMINER’S ANSWER
GROUND OF REJECTION TO BE REVIEWED UPON APPEAL

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner’s Answer mailed January 9, 2008 under the heading “Grounds of rejection to be Reviewed on Appeal” is either unclear or is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection to be reviewed on appeal as provided in the Examiner’s Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set forth in the brief

and an explanation of any disagreement.¹ *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

Specifically, the Final Rejection mailed January 3, 2007 and the Examiner's Answer mailed January 9, 2008 list one of the 35 U.S.C.

§ 103(a) rejections on page 8 as follows:

Claims 43-46, 48, 49, 51, 54-62 and 64-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandretto (US Patent 5,812,988).

Although not included in the statement of the rejection, it is noted that claims 50, 52 and 63 are discussed in subheadings appearing on page 10. Clarification of the record is required regarding the status of claims 50, 52 and 63.

¹ The Appeal Brief filed October 22, 2007 listed this rejection on page 18 as follows:

Issue 1 – Whether claim 43, claim 44, claim 45, claim 46, claim 48, claim 49, claim 50, claim 52, claim 54, claim 55, claim 56, claim 57, claim 58, claim 59, claim 60, claim 61, claim 62, claim 64, claim 65, claim 66, claim 67, claim 68, claim 69, claim 70, claim 71, claim 72, claim 73, claim 74, claim 75, claim 77, claim 78 and/or claim 79 are patentable under 35 USC 103(a) over Sandretto (U.S. Patent 5,812,988).

. . . .

Issue 4 – Whether claim 80, claim 81, claim 82, claim 83 and/or claim 84 are patentable under 35 U.S.C. 103(a) over Sandretto (U.S. Patent 5,812,988)

INFORMATION DISCLOSURE STATEMENT

Appellant filed an Information Disclosure Statement (IDS) dated September 12, 2005. There is no indication on the record that the Examiner has considered the above IDS. MPEP § 609 requires the Examiner to consider any IDS filed by Applicant if timely submitted. A written communication notifying Appellant of the Examiner's consideration of the above IDS is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellant to file a paper which corrects the "Related Proceedings Appendix" of the Appeal Brief filed October 22, 2007;
- 2) for consideration of said paper;
- 3) for clarification regarding the claims involved in the § 103(a) rejection of claims 43-46, 48, 49, 51, 54-62 and 64-85 as being unpatentable over Sandretto (US Patent 5,812,988);
- 4) for consideration and acknowledgement of the IDS filed September 12, 2005; and
- 5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

Application No. 09/761,670

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